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### III. REMARKS

Applicants respectfully request reconsideration of this application in view of the above amendments and the following remarks.

1. Status of the Claims

Claims 1-33, 39 and 44-45 are pending for examination on the merits.

2. Summary of the Amendments

Claims 1, 20, 25, 30-33 and 44 have been amended to delete the phrase "or solvate." Additionally, Claim 1 has been amended to delete "or 2" from the definition of variable *p*. Entry of these amendments is respectfully requested.

3. Rejections Under 35 U.S.C. §112, First Paragraph

Claims 1, 20, 25, 30-33, 39, 44 and 45 have been rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the enablement requirement. Specifically, the Examiner has indicated that the specification allegedly provides insufficient enablement for "all solvates."

Claims 1, 20, 25, 30-33 and 44 have been amended to delete the phrase "or solvate." Accordingly, this rejection may be withdrawn.

4. Obviousness-Type Double Patenting

Claims 1-33, 39 and 44-46 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-22, 28, 29, 33-35 of U.S. Patent Application No. 10/888,855 in view of Wermuth, *The Practice of Medicinal Chemistry*, pp. 204-213, Academic Press, Inc., San Diego, CA (1996). Additionally, Claims 1-33, 39 and 44-45 have been provisionally rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-13 and 18-20 of U.S. Patent Application No. 10/975,657 in view of Berge et al., *J. Pharma Sciences*, 66 (1), pp. 1-2 (1977) supplemented with CA

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60:74793. For the following reasons, Applicants respectfully request that these rejections be withdrawn.

M.P.E.P. 804(I)(B)(1) states that "[i]f a 'provisional' nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer."

In the present case, the present application has an effective filing date of October 29, 2003; U.S. Patent Application No. 10/888,855 has an effective filing date of July 9, 2004; and U.S. Patent Application No. 10/975,657 has an effective filing date of October 28, 2004. Therefore, the present application is the earlier-filed application.

In view of the present amendments and remarks, Applicants respectfully submit that the present obviousness-type double patenting rejections over U.S. Patent Application Nos. 10/888,855 and 10/975,657 are the only remaining rejections in this application. According, pursuant to M.P.E.P. 804(I)(B)(1), Applicants respectfully request that the Examiner withdraw these rejections and permit the present, earlier-filed application to issue as a patent without a terminal disclaimer.

With regard to this issue, the Examiner has stated, in part:

Applicants argued that SN 10/888,855 has a later filing date but provided no reason why applicants' are entitled to prolonged protection through the well known variation of the instantly claimed and elected species....Furthermore, the filing of a terminal disclaimer is not limited to extension of time but also to the unnecessary harassment by multiple assignees were [sic] the patents not commonly owned. Office Action mailed January 23, 2007, at page 3.

In response, Applicants begin by noting that this is not a situation where Applicants already have a granted patent and the Office has found that a second application is an obvious variant. In the present case, Applicants do not have any granted patents on this subject matter. Accordingly, if this application is granted,

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Applicants will not receive "prolonged protection" nor will the public be subject to possible "unnecessary harassment by multiple assignees."

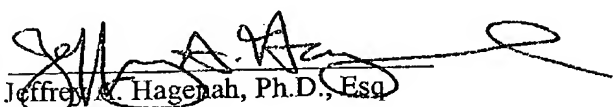
Once this application is granted, if Applicants attempt to patent other subject matter that is deemed an obvious variant of the granted claims, those applications could be properly rejected for obviousness-type double patenting. That is why the MPEP clearly and unambiguously instructs the patent examiner, in situations such as the present one, to withdraw the obviousness-type double patenting rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. Accordingly, Applicants respectfully request that the Examiner withdraw the present rejections and permit the present, earlier-filed application to issue as a patent without a terminal disclaimer.

#### IV. CONCLUSION

Reconsideration of this application in view of the above amendments and remarks is respectfully requested. Should there be any questions regarding this paper or this application, or if the Examiner believes any issues can be resolved by telephone, Examiner is encouraged to call the undersigned attorney for Applicants at (650) 808-6406.

Respectfully submitted,  
THERAVANCE, INC.

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